

## REMARKS/ARGUMENTS

Claims 1-12, 16, 17, 19-30, 34-45, 49 and 50 are pending in the present application. Claims 9-12, 17, 27-30 and 42-45 were previously withdrawn from consideration, and Claims 13-15, 18, 31-33 and 46-48 were previously cancelled. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 103(a), Obviousness**

Claims 1, 5-8, 19, 23-26, 34 and 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, U.S. Patent No. 6,038,553, in view of *Uhland, Sr.*, U.S. Patent No. 5,444,794, and further in view of *Joao et al.*, U.S. Patent Application Publication No. 2001/0051920. This rejection is respectfully traversed.

With respect to Claims 1, 19 and 34, none of the cited references teach or suggest transmitting (1) the image and (2) the transaction result to a mobile device associated with the user. In rejecting Claim 1, the Examiner states:

“Uhland teaches transmitting a check image and a transaction result to a user (column 5 lines 6-21).”

and

“Joao discloses a financial transaction and wireless communication device and method, wherein a user receives transaction notification data, which identifies a transaction, via a mobile device (abstract and paragraph 49).”

Applicants show that *Uhland* states at column 5, lines 6-21 the following:

“Preferred embodiments of the present invention capture images of both sides of a check. In addition, the account number on the check is automatically read by an OCR device. When the teller keys the check amount information into the system, the image of the check, the bank number, account number, check number, and check amount data are placed in a file for: (1) balancing the teller's daily work; (2) debiting the amount of the check from the customer's account (i.e., for on-us checks); (3) **sending check images and amounts back to the account holder**; (4) truncating the check (for on-us checks); and (5) automatically encoding the amount on all non-on-us checks. Regarding the latter operation, the check may be automatically encoded without manual intervention since the account number, bank number, and check number are known.” (emphasis added by Applicants)

However, as stated by *Uhland* at column 1, lines 16-23:

“Newer check processing systems employ imaging to capture digital images of the checks. **Once these digital images have been captured, a bank may send each of its customers monthly statements with images of the customer's**

**cashed checks instead of the checks themselves.** Such image processing allows the checks to be "truncated" prior to shipment to the customer, reducing in-house check processing costs." (emphasis added by Applicants)

and as stated by *Uhland* at column 2, lines 45-55:

"Similarly, on-us read and amount-encoded images (as opposed to the checks themselves) are passed to a balancing station 20, which performs the balancing process with the on-us check images. The on-us images of checks that were not properly amount encoded are provided to a reject key entry station 22. From there, the latter images are passed to the balancing station 20. From the balancing station 20, **the on-us check images are sent to a mainframe computer 24, which prepares customer statements to be sent to the customers associated with the respective checks.**" (emphasis added by Applicants)

and as stated by *Uhland* at column 9, lines 11-15:

"2. A system as recited in claim 1, wherein said computer is further programmed to merge said amount data with said image data, **whereby the preparation of a customer statement depicting an image of said check and amount of said check is enabled.**" (emphasis added by Applicants)

and as stated by *Uhland* at column 10, lines 11-18:

"6. A system as recited in claim 5, wherein said computer is further programmed to merge said amount data with said image data, **whereby the preparation of a customer statement depicting an image of said check and amount of said check is enabled;** and wherein said computer is further programmed to merge multiple on-us check images corresponding to on-us checks associated with a common account number." (emphasis added by Applicants)

Thus, the cited *Uhland* reference only contemplates the sending of a check image to a user by way of the customer's statement, which is traditionally known to those of ordinary skill in the art to be a statement mailed to the user at the end of each month (*Uhland* col. 3, lines 25-30). Importantly, *Uhland* does not contemplate sending a check image to a mobile device, and in fact is keen on reducing overall processing costs by only sending images back to the customer in the account statement (*Uhland* column 6, lines 59-62). Therefore, a person of ordinary skill in the art would not have been motivated to modify the teachings of *Uhland* to include the claimed feature of sending both a check image and a transaction result to a mobile device as such processing would increase transaction processing for which *Uhland* seeks to reduce. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection *unless the prior art suggested the desirability of such a modification*. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (emphasis added by

Applicants). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, *there must be a suggestion or motivation in the reference to do so. In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added by Applicants).

As to the cited *Joao* passage at *Joao*'s abstract and paragraph 49, there *Joao* states:

“An apparatus and method for collecting account transaction information, including a receiver for receiving account transaction information, wherein the account transaction information contains information regarding the transaction and at least one of the identity of and contact information for the at least one of merchant, vendor, bank, financial institution, brokerage firm, electronic money account, communication account provider, electronic information provider, electronic transaction intermediary, involved in the transaction, wherein the receiver receives a request to receive at least one of the account transaction information, the information regarding the transaction, and the at least one of the identity of and contact information for the at least one of merchant, vendor, bank, financial institution, brokerage firm, electronic money account, communication account provider, electronic information provider, electronic transaction intermediary, involved in the transaction, a memory device for storing the account transaction information, a processor for processing at least one of the account transaction information and the request, wherein the processor generates a response to the request, and **a transmitter for transmitting the response to the request to a requesting individual.**” (Abstract); and

“[0049] In another alternate embodiment, the apparatus and method of the present invention may also be utilized so as to provide authorization, notification and/or security for, and in conjunction with wireless communication devices, wireless telephones, cellular communication devices and/or cellular telephones, wireless and/or mobile telephones and/or communication systems, *wherein a wireless, cellular and/or mobile communication devices and/or telephone owner and/or account holder can be notified of a transmission and/or an attempted transmission and/or telephone call made with his or her wireless, cellular, or mobile communication device and/or telephone and/or with the telephone number and/or account information*, which information may include, but not be limited to, transmission codes and/or associated signatures and/or data which corresponds to his or her wireless, cellular, or mobile communication device and/or telephone.”

As can be seen, these cited passages describe (1) transmitting a response to a request to a requesting individual (which does not teach or otherwise suggest transmitting a check image to a mobile device), and (2) *notifying an owner of a mobile device of a transmission or attempted transmission made with their mobile device* (which does not teach or otherwise suggest transmitting a check image to a mobile device). Such notification is made to provide the owner a notification of a possible unauthorized use of such mobile device as being lost, stolen or illegally cloned (*Joao* paragraph 320). Thus, the cited *Joao* reference does not overcome the teaching/suggestion deficiency identified above with respect to the

cited *Uhland* reference, since there is *no teaching/suggestion of transmitting a check image to a mobile device*. Therefore, a proper *prima facie* case of obviousness has not been established by the Examiner<sup>1</sup>, and therefore Claim 1 has been erroneously rejected under 35 U.S.C. § 103<sup>2</sup>.

Applicants initially traverse the rejection of Claims 5-8 for reasons given above with respect to Claim 1 (of which Claims 5-8 depend upon).

Further with respect to Claim 5, the combination of references fails to teach/suggest the claimed feature of sending an alert for the transaction *to a plurality of users associated with an account*, the account being updated based upon the transaction result. The Examiner does not address this claimed feature in the final rejection of Claim 5, and therefore has not properly established a *prima facie* showing of obviousness with respect to Claim 5. Therefore, Claim 5 has been erroneously rejected under 35 U.S.C. § 103.

Further with respect to Claim 8, the combination of references fails to teach/suggest *sending an image of the user with the image of the check to the mobile device*. The Examiner does not address this claimed feature in the final rejection of Claim 8, and therefore has not properly established a *prima facie* showing of obviousness with respect to Claim 8. Therefore, Claim 8 has been erroneously rejected under 35 U.S.C. § 103.

Applicants traverse the rejection of Claims 19, 23-26, 34 and 38-41 for similar reasons to those given above with respect to Claims 1 and 5-8.

Therefore, the rejection of Claims 1, 5-8, 19, 23-26, 34 and 38-41 under 35 U.S.C. § 103(a) has been overcome.

## II. 35 U.S.C. § 103(a), Obviousness

Claims 2, 4, 20, 22, 35 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, in view of *Uhland, Sr.* and *Joao*, as applied above, and further in view of *Jones et al.*, U.S.

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<sup>1</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants).

<sup>2</sup> If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Patent No. 6,661,910. Applicants traverse the rejection of such claims for reasons given above with respect to the missing claimed features associated with Claim 1.

Therefore, the rejection of Claims 2, 4, 20, 22, 35 and 37 under 35 U.S.C. § 103(a) has been overcome.

### III. 35 U.S.C. § 103(a), Obviousness

Claims 3, 21 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, in view of *Uhland, Sr.*, *Joao*, and *Jones*, as applied above, and further in view of the *Souccar* article "Visa in Partnership to Develop Wireless Financial Applications." *Hyde, Uhland*, and *Joao* fail to teach a financial program being on a mobile device.

With respect to Claim 3, the cited *Souccar* reference is a press release announcing a joint development effort to develop a financial application for a mobile device. This press release announces an 'intent to develop' such an application, and thus is actually evidence that such a program *did not exist at the time of the press release*.

This press release is also non-enabling with respect to the features it is alleged to teach, as it states that one company (Visa) must collaborate with another company (Aether Systems) to provide financial applications for mobile devices sometime in the future - evidencing substantial development activities were further required between two large companies for the development of such applications, and thus such applications were not in the possession of the public or of a person of ordinary skill in the art<sup>3</sup>.

Therefore, the rejection of Claims 3, 21 and 36 under 35 U.S.C. § 103(a) has been overcome.

### IV. 35 U.S.C. § 103(a), Obviousness

Claims 49 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, in view of *Uhland, Sr.*, and *Joao*, as applied to Claims 1 and 19 above, and further in view of *Ansley*, U.S. Patent Application Publication No. 2002/0133437.

With respect to Claim 49, the issue is whether the combination of references teaches use of a mobile device as a relay such that the check image and transaction result are transmitted to the mobile device, and this same mobile device transmits this check image and transaction device to another data processing system for processing by a financial program at the another data processing system. One

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<sup>3</sup> Printed publication references must be enabling, thus placing the alleged disclosed matter in the possession of the public. *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994); The reference must be enabling and describe applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *In re Paulsen*, 30 F.3d, 1475, 31 USPQ2d 1671 (Fed. Cir. 1994).

reference teaches transmitting of transaction results (but not a check image) to a mobile device, and another reference teaches sending a transaction (but not a check image) from a mobile device to another data processing system. However, the only teaching/suggestion for performing both of these steps together such that the mobile device is in effect a relay comes from Applicants' own patent application.

As the Federal Circuit outlines in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention “as a whole”. Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtuall all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of invention. *Id.* Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.*

In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, Federal Circuit, No. 04-1493, June 9, 2005. In 1983, the late Judge Howard Markey made the following observation in W.L. Gore & Associates Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), which states the basic interest protected by this test—improper hindsight analysis of prior art:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Applicants respectfully submit that the Examiner is using impermissible hindsight in rejecting Claim 49.

Still further, because the cited *Ansley* reference is directed to a technique for synchronizing data between a mobile device and a data processing system, a person of ordinary skill in the art would not have

been motivated to add yet an additional data processing system as then there would be three sources of data (the two data processing systems and the mobile device), and it would be unclear which data is to be synchronized due to such large number of systems. For example, would the data in the first system be the master data that is used to override other data that is inconsistent, or should the second system (or the mobile device itself) be considered the master in data synchronization? When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. “...absence of such suggestion to combine is dispositive in an obviousness determination”. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). Quite simply, synchronization doesn’t work well with three distinct devices/systems, and therefore a person of ordinary skill in the art would not have been motivated to add an additional data processing system to the teachings of *Ansley* as the expressed purpose of *Ansley* – data synchronization – would be adversely impacted, and therefore there would have been no suggestion or reason to make such a combination.

Still further, even with such improper combination using Applicants own disclosure as a blueprint in making the combination of four different references, such resulting combination does not teach the use of a relay, by a mobile device, of *both the transaction result and the check image*, for similar reasons to those described in detail above with respect to Claim 1.

Further yet, *Ansley*’s teachings, which are being used to establish a communication link and data transfer to the ‘another data processing system’ has no ability to process or input check images as the data that is transmitted to the another data processing system is manually entered by a user of the mobile device (*Ansley* Figure 6, block 640; paragraph 0047). Thus, the teachings of *Ansley* do not provide a teaching/suggestion of transmitting the image to another data processing system, as expressly recited in Claim 49 (in combination with Claim 4).

Thus, it is urged that Claim 49 has been erroneously rejected under 35 U.S.C. § 103 for the numerous reasons given above, including (1) improper hindsight analysis, (2) no suggestion or reason to combine the references, and (3) even with the improper combination of such a large number of references, there are still missing claimed features not taught or suggested by the cited references.

Applicants traverse the rejection of Claim 50 for similar reasons to those given above with respect to Claim 49.

Therefore, the rejection of Claims 49 and 50 under 35 U.S.C. § 103(a) has been overcome.

**V. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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